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| 09/877,317      | 06/08/2001  | John J. Sie          | 19281-001610        | 9420             |

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EXAMINER

BOUTAH, ALINA A

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/877,317

Applicant(s)

SIE ET AL.

Examiner

Alina N Boutah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

RD

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to Applicant's amendment filed March 7, 2005. Claims 1-21 are pending in the application.

### ***Content of Specification***

Applicant has provided a summary of the invention in the specification. Therefore the objection is now withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose "discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program" as specified in the claimed invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,701,528 issued to Arsenault et al. (hereinafter Arsenault).

Regarding claim 1, Arsenault teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (abstract; figure 8A: 804);

detecting the user request for one of the first plurality of programs (col. 2, lines 22-25);

recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires (abstract; figures 8A-C; col. 2, lines 22-41; col. 3, lines 24-37; col. 12, line 55 to col. 13, line 65); and

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recording the one of the first plurality of programs if the user request is detected before the stagger period expires (abstract; figure 8; col. 2, lines 22-41; col. 3, lines 24-37; col. 12, line 55 to col. 13, line 65).

Regarding claim 2, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the stagger period is a time duration between beginning the first plurality of programs and the second plurality of programs (col. 2, lines 8-21).

Regarding claim 3, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the content provider is a cable television provider (col. 1, line 14).

Regarding claim 4, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first plurality of programs are multiplexed together in a single datastream (col. 2, lines 32-33).

Regarding claim 5, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein: the first plurality of

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programs is transported with a first transponder, and the second plurality of programs is transported with a second transponder (col. 18, lines 25-30).

Regarding claim 6, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, further comprising a step of playing the one of the first plurality of programs (col. 2, lines 22-25).

Regarding claim 7, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the detecting step comprises steps of: receiving a wireless request from a remote control (col. 16, lines 26); and processing the wireless request to determine a desired program (col. 16, lines 25-49).

Regarding claim 8, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).

Regarding claim 9, Arsenault teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

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determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored (col. 11, line 60 to col. 12, line 5);

recording any first segment of each of the plurality of programs that are not already stored (col. 12, line 55 to col. 13, line 65);

detecting the user request for one of the plurality of programs (col. 2, lines 22-25); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 2, lines 22-42; col. 12, line 55 to col. 13, line 65).

Regarding claim 10, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (figure 8; col. 2, lines 22-25).

Regarding claim 11, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels (figure 8).

Regarding claim 12, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (col. 18, lines 25-30).

Regarding claim 13, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (col. 2, lines 22-25).

Regarding claim 14, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control (col. 16, line 26); and processing the wireless request to determine a desired program (col. 16, lines 25-49).

Regarding claim 15, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).



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Regarding claim 16, Arsenault teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording at least a segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (figure 8A);

detecting the user request for one of the first plurality of programs (col. 2, lines 22-42);  
and

continuing to record the one of the first plurality of programs beyond a stagger period based upon the detecting step (col. 12, line 55 to col. 13, line 65).

Regarding claim 17, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the stagger period is the time between beginning the first plurality of programs and a second plurality of programs (figure 8B).

Regarding claim 18, Arsenault teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the recording step comprises a step of recording the segment on a mass storage device associated with a set top box that is proximate to the user location (col. 2, lines 22-41).

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Regarding claim 19, Arsenault teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of the program sent from the content provider before any user request for the program (figure 8A);

detecting the user request for the program (col. 2, lines 22-25);

recording a second segment of the program if the user request is detected before the period expires (col. 2, lines 22-42; col. 12, line 55 to col. 13, line 65); and

discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program (col. 12, line 55 to col. 13, line 65).

Regarding claim 20, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 2, lines 22-42).

Regarding claim 21, Arsenault teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 6, lines 56-59).

***Response to Arguments***

Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

Applicant argues that Arsenault is not a prior art because it was filed January 25, 2000, whereas, the present application claims the priority date of its parent application (Provisional Patent Application No. 60/163,324) that was filed on November 3, 1999. The present application is a continuation-in-part of 60/163,324. The Patent Office respectfully submits that Arsenault is a valid prior art because the cited area provided by Applicant does not support each and every limitation in the rejected claims. For example, the cited area does not teach "recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs...recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires and recording the one of the first plurality of programs if the user request is detected before the stagger period expires." Moreover, the parent application fails to disclose the first and second plurality of programs being transported with first and second transponders, respectively.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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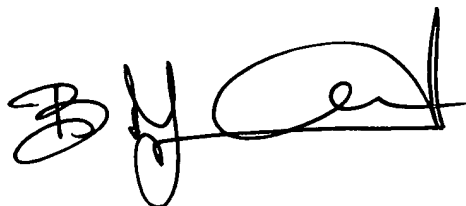
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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